

008020-9062560

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18 Attorneys for Defendant VYSIS, INC.

19 UNITED STATES DISTRICT COURT
20 SOUTHERN DISTRICT OF CALIFORNIA

21 GEN-PROBE INCORPORATED,

22 Plaintiff,

23 v.

24 VYSIS, INC.,

25 Defendant.

No. 99CV2668 H (AJB)

DECLARATION OF NORVAL B. GALLOWAY

Date: September 15, 2000
Time: 9:30 a.m.
Dept.: Courtroom A

26 I, Norval B. Galloway, declare:

27 1. I am Patent Counsel for Vysis, Inc., the defendant in the present litigation between
28 Gen-Probe Incorporated (Gen-Probe) and Vysis, Inc. (Vysis).

29 2. Vysis is a small company with limited financial resources. Vysis employs only two
30 in-house lawyers, its general counsel and me. I am Vysis's in-house patent attorney and the only
31 attorney at Vysis with detailed familiarity with the patent-in-suit, U. S. Patent No. 5,750,338 (the
32 '338 patent), its history, and the technical subject matter and issues involved in this suit. I am also
33 the only attorney at Vysis with detailed familiarity with the '338 patent reissue application now
34 before the Patent Office. There is no one else at Vysis who can knowledgeable and efficiently

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CLERK OF DISTRICT COURT

BY:

DEPUTY



1 interact with Vysis's outside counsel in these two proceedings involving the '338 patent. I believe
2 my participation in both proceedings involving the '338 patent is critical to protecting the interests of
3 Vysis and instructing outside counsel in those cases.

4 3. Vysis and Gen-Probe, parties in the present suit, were previously both parties in Case
5 No. 95-CV-998-J (BTM), a patent infringement suit also filed in the Southern District of California.
6 That case was filed by Gen-Probe alleging that the activities of Vysis in a number of areas, including
7 assays for infectious diseases, infringed Gen-Probe's patents. The parties stipulated to a protective
8 order in the case that specifically allowed both Vysis and Gen-Probe to designate an in-house
9 attorney and two officers, directors or employees with free access to all of the opposing parties'
10 confidential information. All attorneys of record also had full access to confidential information
11 produced in discovery. Gen-Probe did not try to restrict access to confidential information by any of
12 Vysis's in-house counsel or its corporate officers, or impose any restriction on patent prosecution
13 activity. A copy of that protective order is attached as Exhibit A. Gen-Probe has not accused Vysis
14 of violating the previous protective order or of misusing Gen-Probe's confidential information from
15 that case.

16 4. The previous case settled on August 10, 1999. The terms of the settlement effectively
17 prohibit Vysis from competing with Gen-Probe in the field of infectious disease testing. The terms
18 prohibit Vysis from using tests it developed to compete with Gen-Probe for the detection of
19 infectious diseases. Vysis has never competed in the blood screening field in which the Gen-Probe
20 NAT test kit products that are the subject of this action compete.

21 5. As an additional condition of settling the previous patent infringement lawsuit, Gen-
22 Probe insisted upon a license under Vysis's '338 patent, one of the Collins patents, the patent-in-suit.
23 Three letters between the parties discussing the settlement, two dated March 29, 1999 and one dated
24 April 9, 1999, are attached to this declaration as Exhibits B, C and D.

25 6. On December 22, 1999, just three and one-half months after the previous suit was
26 settled, Gen-Probe filed this new lawsuit against Vysis, asking for declaratory judgment that the '338
27 patent is invalid or not infringed, and to excuse Gen-Probe from paying royalties due under the
28 license.

1 7. On March 8, 2000, Vysis filed a patent reissue application with the PTO for the '338
2 patent based on a belief that the patent is partially inoperative for failure to assert claims of
3 intermediate scope. The new claims that Vysis proposes to add to the patent through the reissue
4 process are narrower than the broadest claims in the original patent and do not cover subject matter
5 outside that already encompassed by the original patent claims. The reissue proceeding is being
6 conducted on the public record to which the public has full access. Gen-Probe has been provided
7 with a copy of the reissue application. I understand Gen-Probe has filed a protest to the application
8 with the PTO.

9 8. Vysis is represented in this litigation by outside counsel, Finnegan, Henderson,
10 Farabow, Garrett & Dunner (Finnegan Henderson) and specifically by Charles E. Lipsey. It has
11 retained Wright & L'Estrange as local counsel to assist Finnegan Henderson with local procedures.
12 Mr. Lipsey has substantial familiarity with the '338 patent and the relevant technology. His
13 participation in both this litigation and the patent reissue proceeding are essential for protecting
14 Vysis's legal interests. Neither Finnegan Henderson, Wright & L'Estrange, nor any of their
15 attorneys or staff do any patent prosecution for Vysis other than the application to reissue the '338
16 patent.

17 9. Apart from the reissue application, Finnegan Henderson does not represent Vysis in
18 patent prosecution matters. Finnegan Henderson has no general familiarity with Vysis' portfolio of
19 intellectual property and provides no regular advice to Vysis with respect to Vysis' research,
20 development, and business activities. To the contrary, Vysis regularly is represented by a number of
21 firms other than Finnegan Henderson for patent prosecution and business matters. Finnegan
22 Henderson's representation of Vysis is limited to adversarial matters such as this litigation and issues
23 relating to them. Finnegan Henderson has previously represented Vysis in matters involving
24 Gen-Probe, including the prior litigation identified in paragraph 3 above. Finnegan Henderson
25 became familiar with the '338 patent and the history of this case as a result of that prior
26 representation. Thus, I believe it is essential for Vysis that Finnegan Henderson represents Vysis
27 with respect to the reissue application as well as this lawsuit.
28

10. Gen-Probe's current HIV and HCV kits licensed under the '338 patent are widely distributed to blood screening institutions. These kits are distributed with a package insert detailing the operation of the test. To date, Gen-Probe has refused to produce documents or permit discovery with respect to future products. Attached as Exhibits E and F are letters dated July 31, 2000, and August 3, 2000, between counsel for the parties that relate to these discovery discussions. Attached as Exhibit G is Gen-Probe's response to Vysis's second set of document requests, of which Requests Nos. 3-5, 7, 21, 23-25, and 31-41 are relevant.

11. According to publicly available information, Gen-Probe is a wholly-owned subsidiary of Chugai, a large Japanese pharmaceutical company. Mr. R. William Bowen, Jr. is its general counsel. It is my understanding that he oversees all legal matters for Gen-Probe and has a role in advising the company on planning, policy, future product development and other company-wide decisions. Mr. Peter R. Shearer is Gen-Probe's Vice President [of] Patents and I understand that he manages all of Gen-Probe's patent prosecution and plays a major role in protecting its intellectual property interests. I understand Christine A. Gritzmacher to be an in-house attorney for Gen-Probe who prosecutes patents.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct and that this declaration was executed on the 29th day of August, 2000, at Downers Grove, Illinois.

Norval B. Galloway
Norval B. Galloway

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	<u>Exhibit</u>	<u>Description</u>	<u>Page</u>
1			
2	A	November 24, 1995 Stipulated Protective Order re	6
3		Confidential Information in <u>Gen-Probe, Inc. v. Amoco Corp.</u> ,	
4		Case No. 95-CV-998-J (BTM).	
5	B	March 29, 1999 letter from J.L. Bishop to H.L. Nordhoff.	20
6	C	March 29, 1999 fax letter from H.L. Nordhoff to J.L. Bishop.	24
7	D	April 9, 1999 letter from J.L. Bishop to H.L. Nordhoff.	29
8	E	July 31, 2000 letter from Thomas W. Banks to Patrick M.	31
9		Maloney.	
10	F	August 3, 2000 letter from Patrick M. Maloney to Thomas W.	33
11		Banks.	
12	G	June 20, 2000 Gen-Probe's responses to Vysis' Second Set of	37
13		Requests for Production of Documents.	
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EXHIBIT A

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LYON

4250 EXECUTIVE SQUARE, SUITE 660

LA JOLLA, CA 92037

(619) 552-8400

1 LYON & LYON
2 A Partnership Including
3 DOUGLAS E. OLSON (State Bar No. 38649)
4 A Professional Corporation
5 MARY S. CONSALVI (State Bar No. 130966)
6 MATTHEW W. KNIGHT (State Bar No. 150209)
7 F.T. ALEXANDRA MAHANEY (State Bar No. 125984)
8 4250 Executive Square, Suite 660
9 La Jolla, California 92037
10 (619) 552-8400

11 Attorneys for Plaintiff
12 GEN-PROBE INCORPORATED

13 UNITED STATES DISTRICT COURT
14 FOR THE SOUTHERN DISTRICT OF CALIFORNIA

15 GEN-PROBE INCORPORATED, a
16 Delaware Corporation

17 Plaintiff,

18 v.

19 AMOCO CORPORATION, an Indiana
20 Corporation, AMOCO TECHNOLOGY
21 COMPANY, a Delaware
22 Corporation, GENE-TRAK SYSTEMS,
23 INC., a Delaware Corporation,
24 and VYSIS, INC., a Delaware
25 Corporation,

26 Defendants.

Case No. 95-CV-998-J (BTM)

STIPULATED PROTECTIVE ORDER RE
CONFIDENTIAL INFORMATION

27 WHEREAS, the discovery and pretrial phase of this action will
28 involve disclosure of trade secrets and other confidential and
29 proprietary business, technical and financial information, the
30 parties hereby stipulate and request that the Court enter the
31 following order pursuant to Rule 26(c) of the Federal Rules of
32 Civil Procedure:

SSSD/915. v01

55
Exhibit A
6

FILED

24 1995

CLERK U.S. DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA
BY *[Signature]*

LYON RON

4250 EXECUTIVE SQUARE, SUITE 660
LA JOLLA, CA 92037
(619) 552-8400

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8

[Signature]

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LYON, YON

4250 EXECUTIVE SQUARE, SUITE 660

LA JOLLA, CA 92037

(619) 552-8400

~~1 before any court, agency or tribunal as evidence of or concerning~~
~~2 whether or not such information is confidential or proprietary.~~

3 17. Return of Information. At the conclusion of this action
4 whether by judgment and exhaustion of all appeals, or by
5 settlement, all Confidential Information and all documents which
6 reflect such information shall be (i) delivered to the party that
7 furnished such Confidential Information, or (ii) in lieu of
8 delivery to the furnishing party, destroyed, in which event counsel
9 shall give written notice of such destruction to opposing counsel.
10 The attorneys of record shall insure that all the Confidential
11 Information in the possession, custody or control of their experts
12 and consultants is also destroyed or returned to the party that
13 furnished such Confidential Information. In no event shall a
14 party, their experts or consultants retain a copy of Confidential
15 Information produced to it.

16 18. Court's Jurisdiction. The Court retains jurisdiction to
17 make such amendments, modifications, deletions and additions to
18 this Order as the Court may from time to time deem appropriate.
19 The provisions of this Order regarding the use and/or disclosure of
20 Confidential Information and Confidential -- For Counsel Only
21 information shall survive the termination of this action, and the
22 Court shall retain jurisdiction with respect to this Order.

23 19. Jurisdictional Effect. An entity's stipulation to this
24 Protective Order shall have no effect on that entity's right to
25 file a motion under Fed. R. Civ. P. 12 or challenge this Court's
26 jurisdiction over said entity.

27 ///

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LA JOLLA, CA 92037

(619) 552-8400

20. Third Party Rights. This order is without prejudice to the rights of any third party.

LYON & LYON

Dated: Oct 20 1995

By: Mary S. Consalvi
MARY S. CONSALVI
Attorneys for Plaintiff,
GEN-PROBE INCORPORATED

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER

Dated: November 8, 1995
By: Gerson S. Panitch
GERSON S. PANITCH
Attorneys for Defendants,
AMOCO CORPORATION, AMOCO TECHNOLOGY
COMPANY, GENE-TRAK SYSTEMS, INC.
and VYSIS, INC.

WRIGHT & L'ESTRANGE

Dated: Nov. 10, 1995

By: John H. L'Estrange Jr
Co-Counsel for Defendants,
AMOCO CORPORATION, AMOCO TECHNOLOGY
COMPANY, GENE-TRAK SYSTEMS, INC.
and VYSIS, INC.

ORDER

IT IS SO ORDERED as modified in writing by the Court

Dated: November 28
October, 1995

United States District Judge
Negotiate

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EXHIBIT B



March 29, 1999

BY FACSIMILE

Gen-Probe Incorporated
10210 Genetic Center Drive
San Diego, CA 92121-4362

Attention: H.L. Nordhoff, President &
Chief Executive Officer

Settlement Proposal

Dear Hank:

Thank you for meeting with us last Wednesday. We remain hopeful that an acceptable settlement can be found so that our companies can get on with their main business activities. Thus, as agreed, we have developed the attached alternative settlement proposal for your review and consideration.

We look forward to receiving Gen-Probe's proposal.

Best regards,

J.L. Bishop,
President and CEO
Attach.

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[illegible]

1. The Amoco defendants will agree not to challenge directly or indirectly the validity of the Kohne '330 and '611 patents in the future.

2. Gen-Probe will agree not to challenge directly or indirectly the validity of the Vysis Listeria patent in the future.

3. Gen-Probe will grant Vysis a limited worldwide, nonexclusive, royalty-free immunity from suit for assays for detecting or quantifying ribosomal nucleic acids for food testing applications covered by any claim of the Kohne '330 or '611 patents.

4. Vysis will grant Gen-Probe a worldwide, nonexclusive, royalty-free license under the Listeria patent.

5. Gen-Probe will release the Amoco defendants for alleged past infringement of Gen-Probe patents and dismiss its pending causes of action in the patent case.

6. Vysis will release Gen-Probe for all claims of alleged past infringement of Vysis patents and dismiss its pending causes of action in the patent case.

B. OTHER PATENTS

7. Gen-Probe will be permitted to take a worldwide, nonexclusive license under ribosomal nucleic acid probe patents owned by Vysis (Vysis' probe library) as of the settlement date at a royalty rate of 2% of future sales of products or services covered by the patents to the ultimate consumers or users of such products and services (Net Sales).

8. Vysis will grant to Gen-Probe an option, exercisable within 9 months of the settlement date to acquire a worldwide, nonexclusive license under the RTC patents for a \$2 million up-front license fee and a running royalty of 6% of Net Sales made after the settlement date.

9. Vysis will grant to Gen-Probe an option, exercisable within 9 months of the settlement date to acquire a worldwide, nonexclusive license for detecting and quantifying ribosomal nucleic acids under the Stanbridge patent for a royalty of 5% (to be reduced to 3% as partial consideration for this settlement) of Net Sales made after the settlement date.

10. Gen-Probe shall be free at any time, without surrendering its option rights granted above, to mount any challenge to the validity or enforceability of the Stanbridge or RTC patents either as an appropriate proceeding before the U.S. PTO or in the appropriate federal district court. During the course of any such proceeding, Gen-Probe may either repudiate any license(s) it may have acquired under the patent(s) and cease paying royalties, thereby subjecting itself to all appropriate awards of compensatory and punitive damages, costs, attorney fees, and injunctive relief, or may keep the license(s) in force by continuing to pay the royalties due under the agreement. In the event that Gen-Probe's challenge does not result in a judgment that all claims of the relevant patent(s) infringed by Gen-Probe are invalid or unenforceable, the royalty rate under such extant license or option shall be increased by 2% effective as of the date of the trial court or administrative decision to that effect.

Exhibit B
22

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C. MALICIOUS PROSECUTION CASES

11. Amoco will pay Gen-Probe, in addition to the considerations listed above, \$1 million and Kohne \$250,000.

12. Kohne, Gen-Probe and Chugai will grant a general release, including a release of unknown claims, associated with prosecution of the UC and CNS cases and dismiss with prejudice the pending malicious prosecution actions.

D. GENERAL PROVISIONS

13. The licenses and/or immunities provided under the agreement would be transferable only with the sale of the business or of substantially all of the assets to which the business relates. The discounted royalty rate specified in paragraph 9 is personal to Gen-Probe. In the event of the sale of Gen-Probe's business or of substantially all of Gen-Probe's assets to which Gen-Probe's business relates, any surviving license under the Stanbridge patent will include a running royalty of 5%.

14. The terms of the settlement shall be confidential except that the terms of the licenses and/or immunities granted may be disclosed by a party to the extent necessary to comply with applicable securities laws.

Exhibit B
23

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EXHIBIT C



BAK-29-99 MON 17:55

FAX NO.

1901

P.01

C. Files

Settlement

WGP.

GEN-PROBE INCORPORATED

10210 Civic Center Drive, San Diego, CA 92121

Phone: (619) 410-8902 Fax: (619) 410-8901

Facsimile

Date: March 29, 1999

To: John L. Bishop

From: H. L. Nordhoff

Fax: 630 271 7078

Pages to Follow: 2

Message:

Dear John:

Attached please find our proposal. I know you will give it serious consideration for we are both anxious to get back to business and grow our respective companies. The terms should be viewed together.

I look forward to hearing from you and doing our best to settle this matter.

Sincerely,

H. L. Nordhoff
H. L. Nordhoff

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Exhibit C

24

CONFIDENTIAL NOTICE

The information contained in this facsimile message is confidential information intended only for use of the addressee(s) named above. If the reader of this message is not the intended recipient, or the employee or agent responsible for delivering this message to the intended recipient, please note that any distribution or copying of this communication is strictly prohibited. Anyone who receives this communication in error, should notify us immediately by telephone, and return the original message to us at the above address via the U.S. Postal service.

Transmission Problems (619) 410-8903

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OUTLINE OF SETTLEMENT TERMS PROPOSED BY GEN-PROBE

Resolution of litigation

- GP withdraws its patent infringement suit against Amoco/Vysis and releases Amoco/Vysis from claims of past infringement.
- Amoco/Vysis withdraw their patent infringement counterclaim against GP and release GP from claims of past infringement.
- GP withdraws its malicious prosecution suit against Amoco/Vysis and releases Amoco/Vysis from all claims therein in return for a cash payment of \$10 million from Amoco/Vysis to GP.
- Amoco/Vysis agree to withdraw from active participation in pending oppositions to the Kohne European patents, including the pending EPO appeal, and agree not to initiate any future proceedings (directly or through any third party) or to induce any third party to initiate any proceedings or provide assistance to any third party in proceedings in any countries challenging the validity or GP's ownership of the Kohne patent rights or any other patent rights of GP relating to the use of nucleic acid probes to detect ribosomal RNA.
- Amoco/Vysis stipulate to the validity of all claims in issued Kohne patents worldwide and stipulate that GP is the rightful legal owner of all Kohne patent rights.

Exchange of intellectual property rights

- GP grants Amoco/Vysis a paid-up, royalty-free, non-exclusive, worldwide license under any claim of the Kohne '330 or '611 patents solely for use in the field of food testing.
- Amoco/Vysis grant GP a paid-up, royalty-free, non-exclusive, worldwide license under any patents owned or controlled by Amoco/Vysis that are directed to the detection of *Listeria*, including without limitation Stackebrandt.
- Amoco/Vysis grant GP a paid-up, non-exclusive, royalty-free, worldwide license under Collins patents in return for a payment of \$5 million.
- Amoco/Vysis grant GP a paid-up, non-exclusive, royalty-free, worldwide sublicense under the Stanbridge patent in consideration of one dollar and other considerations recited herein.
- GP receives a life-of-patent option for a non-exclusive, worldwide license under all Amoco/Vysis patents covering probes for detection of ribosomal RNA sequences. GP may exercise such option with respect to individual patents or groups of patents. Such licenses shall be royalty free for any patent based on an application having an effective filing date after July 25, 1989 and shall bear a commercially reasonable royalty not to exceed 2%, to be negotiated in good faith, for any patent based on an application having an effective filing date before July 25, 1989.

- All licenses granted herein may be sublicensed by the licensee to an affiliate or commercial collaborator or for use in connection with other significant out-licensed technology (provided, that neither party may sublicense such rights to an existing collaborator or licensee of the party granting such license) and may be assigned only in connection with a sale or transfer of essentially all of the licensee's business.

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WHL CP 100
GP Settlement Dis.

April 9, 1999

BY FACSIMILE

Gen-Probe Incorporated
10210 Genetic Center Drive
San Diego, CA 92121-4362

Attention: H.L. Nordhoff, President &
Chief Executive Officer

Settlement Negotiations

Dear Hank:

We remain interested in pursuing resolution of the various issues pending between our firms. I would like to see if that can be done now that we have already found agreement to some of the patent issues and now that Judge Prager seems to have finalized his ruling on Amoco's Motion for Summary Judgment in the malicious prosecution case. I understand, for example, that Gen-Probe's counsel acknowledged to Judge Prager at the hearing Wednesday that the case was brought to provide Gen-Probe with additional leverage regarding the outstanding patent issues. Although we did not see that the case strengthened Gen-Probe's position, Judge Prager's recent rulings should confirm that any additional leverage and any corresponding damage recovery that Gen-Probe might have expected from it are simply not forthcoming.

At the same time, I think we have already found resolution to many substantial issues regarding our respective patents. Vysis will agree, for example, to forego activities in clinical diagnostics utilizing ribosomal nucleic acids. We will also agree to make our probe library available to Gen-Probe. I think you would agree these represent substantial concessions on our part. In return, Gen-Probe has indicated it will provide us with freedom to operate our Gene-Trak food diagnostics business. Finally, Vysis can also agree that the Collins and Stanbridge patents can be separated from consideration and settlement of the pending litigations. Again, we believe this should simplify matters rather than complicate them.

I had understood that Gen-Probe had decided that further settlement discussions would be unproductive. However, I understand now from Bill's recent letter to Tom Ryan, that Gen-Probe is agreeable to further discussions albeit without Judge Prager's assistance. As I said earlier, we remain interested in resolving the issues between our firms. Given the present postures of the cases and the substantial agreement already reached, we believe further discussions will be useful. And, as you and I agreed during our last meeting in San Diego, it would be far better for each of us to resolve the litigations so that we can refocus our attention on our own businesses.

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SECRET

Best regards,

J.L. Bishop,
President and CEO

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EXHIBIT D



April 9, 1999

BY FACSIMILE

Gen-Probe Incorporated
10210 Genetic Center Drive
San Diego, CA 92121-4362

Attention: H.L. Nordhoff, President &
Chief Executive Officer

Settlement Negotiations

Dear Hank:

We remain interested in pursuing resolution of the various issues pending between our firms. I would like to see if that can be done now that we have already found agreement to some of the patent issues and now that Judge Prager seems to have finalized his ruling on Amoco's Motion for Summary Judgment in the malicious prosecution case. I understand, for example, that Gen-Probe's counsel acknowledged to Judge Prager at the hearing Wednesday that the case was brought to provide Gen-Probe with additional leverage regarding the outstanding patent issues. Although we did not see that the case strengthened Gen-Probe's position, Judge Prager's recent rulings should confirm that any additional leverage and any corresponding damage recovery that Gen-Probe might have expected from it are simply not forthcoming.

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APR 15 1999

FINNEGAN, HENDERSON
BRADY, GARRETT & DUNN, LLP

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April 9, 1999
Gen-Probe Incorporated
Page 2

I look forward to your suggestions as to how best to proceed.

Best regards,



J.L. Bishop,
President and CEO

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EXHIBIT E

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P.

STANFORD RESEARCH PARK
700 HANSEN WAY
PALO ALTO, CALIFORNIA 94304

WASHINGTON
202-408-4000

ATLANTA
404-633-6400

TELEPHONE 650-849-6600
FACSIMILE 650-849-6666

WRITER'S DIRECT DIAL (650) 849-6630
THOMAS.BANKS@FINNEGAN.COM

TOKYO
011-81-3-3431-6943

BRUSSELS
011-32-2-646-0353

July 31, 2000

VIA FACSIMILE

Patrick M. Maloney, Esq.
Cooley Godward LLP
4365 Executive Drive
Suite 1100
San Diego, CA 92121-2128

Re: Gen-Probe Incorporated v. Vysis, Inc.

Dear Pat:

Thank you for your July 28, 2000 letter summarizing our telephonic meet and confer of July 26, 2000. For the most part, your letter accurately reflects our discussion. There is, however, one inaccuracy. It is my recollection that you agreed to consider whether the "or associated with" language in paragraph 5(f) of the proposed Protective Order could be removed. Please let me know if you disagree.

In our follow-up July 28, 2000 meet and confer, we discussed whether the parties might agree to a specified person or persons who would have access to Gen-Probe Confidential or Confidential-Attorneys Only information and who would not be precluded from assisting in the prosecution of the '338 patent reissue application. Vysis will consider this possibility.

We also discussed in the July 28 meet and confer Gen-Probe's responses to Vysis document requests. Specifically, we discussed Gen-Probe's responses limiting Gen-Probe's production of documents to its NAT test kits for HCV or HIV. See Gen-Probe responses to requests 3-5, 7, 21, 23-25 and 31-41. You stated your belief that the declaratory judgment complaint related only to HCV and HIV products and that these two were the only imminent commercial NAT kit products. I asked whether Gen-Probe would further amend its complaint if during the pendency of the litigation Gen-Probe introduced NAT test kits for other products. You said you would consider this question.

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Patrick M. Maloney, Esq.
Cooley Godward LLP
July 31, 2000
Page 2

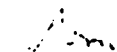
We also discussed Gen-Probe's objection to producing documents broadly relating to its NAT test kits for HCV or HIV and its response that it would produce "a complete set of non-privileged design specification documents concerning the design and method of operation of such documents." See Gen-Probe responses to Vysis document requests 3-5, 7, 9, 21, 23, and 42-43. We discussed whether Gen-Probe would produce only the final design specification documents or would produce all preliminary design specifications created during product development. We also discussed whether responsive research and development documents such as laboratory notebooks would be produced. You said you would consider these issues.

Finally, we discussed Gen-Probe's response to Document Request No. 6 and whether or not it will produce a sample of its NAT test kits for use in detecting HCV and HIV to Vysis under the terms of the Protective Order. You also wanted to consider this matter further.

We agreed that the parties will not raise issues regarding the scope of discovery with Magistrate Battaglia tomorrow. You raised the notion that we might want to obtain the magistrate's views on issues relating to the Protective Order, particularly paragraph 5. As we discussed on Friday, we are presently doing legal research on issues raised by paragraph 5 and will consider the cases you brought to our attention. After we complete the legal research, we will consider a compromise to your proposed paragraph 5. This is an important issue for Vysis because it impacts Vysis's ability to defend this lawsuit and to effectively prosecute the reissue application. Accordingly, we will most likely not be in a position to propose any alternative to paragraph 5 until the end of this week.

Please let me know if I have misstated or misunderstood any point from our meet and confer discussions. I'd like to thank you and Matt for the spirit of cooperation displayed during these discussions.

Sincerely,



Thomas W. Banks

TWB/sls

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EXHIBIT F

Cooley Godward LLP

ATTORNEYS AT LAW

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PATRICK M. MALONEY
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August 3, 2000

VIA FACSIMILE

Thomas W. Banks, Esq.
Finnegan, Henderson, Farabow, et al.
700 Hansen Way
Palo Alto, CA 94304

Re: Gen-Probe Incorporated v. Vysis, Inc.

Dear Tom:

Thank you for your letter of July 31, 2000, which summarizes our telephone conference of July 28, 2000. I write to add to the record several points not contained in your letter and to clarify certain aspects of your letter.

First, I wish to further elaborate on our discussions concerning the limiting language contained in Gen-Probe's responses to Vysis' document requests 3-5, 7, 9, 21, 23, and 42-43. Specifically, Gen-Probe agreed in its responses to produce all "a complete set of non-privileged design specification documents concerning the design and method of operation of such products." During our meet and confer, you asked whether Gen-Probe intended to produce design and specification documents with respect to each and every iteration of the HIV and HCV test kits or whether Gen-Probe's production would be limited to merely the final, commercialized versions of these products. As I explained, it is Gen-Probe's position that the only design and specification documents that are relevant are those that describe the HCV and HIV products that Gen-Probe has commercialized. Thus, Gen-Probe has agreed to produce and will produce documents so that Vysis may evaluate Gen-Probe's claim of non-infringement with respect to its commercial products. Gen-Probe will resist, however, Vysis' efforts to engage in a fishing expedition through Gen-Probe's sensitive and confidential research and development documents and materials, including its laboratory notebooks.

Next, I would like to confirm the agreements we reached with respect to Vysis and the third parties' (Banks; BP Amoco; Galloway; and Finnegan, Henderson) discovery responses. In regards to Vysis and the third parties' (collectively the "responding parties") "effective filing date" objection, the parties still harbor differing opinions about the relevancy of some later created documents. Nevertheless, the responding parties will respond to the affected document requests by producing all responsive documents created before December 21, 1987 and those responsive documents created after December 21, 1987 that refer to documents created or events that occurred before that date. Nothing herein shall be construed as a waiver of Gen-Probe's right to pursue discovery of documents created after December 21, 1987.

Thomas W. Banks, Esq.
August 3, 2000
Page Two

Finally, as you will recall, during our conversation, Matt Lehr and I advised you that there are several other discovery issues that we would raise by way of a letter. These issues are set forth below:

The third party witnesses have objected to producing documents that are owned by Vysis and have stated that the documents sought from them will be produced in response to the document requests propounded to Vysis. See e.g. Third Party Thomas W. Banks' Objections and Responses to Plaintiff Gen-Probe Incorporated's Subpoena for Production of Documents ("Banks' Subpoena Responses"), General Objection 8. Gen-Probe is entitled to know which of the various persons and entities from which it is seeking discovery are in possession of the documents sought. Thus, please ensure that each responding party produces all of the documents sought, irrespective of whether they are owned and produced by Vysis. Alternatively, we would be willing to consider accepting a collective, single set of Vysis' documents, so long as you also identify by bates number, at the time of production, which of those documents were in the possession of the various third parties at the time that service of Gen-Probe's subpoenas was deemed completed.

Vysis and the third party witnesses have objected to producing documents created after December 22, 1999, which is the date on which the Complaint was filed. See e.g. Banks' Subpoena Responses, General Objection 5. Gen-Probe does not seek to discover work-product documents created after this date or require that such documents be identified in a privilege log. Gen-probe does request, however, that Vysis and the third parties produce any and all responsive documents that have been created in the ordinary course of business. Please ensure and confirm that all such documents are produced.

Cooley Godward LLP

Thomas W. Banks, Esq.
August 3, 2000
Page Three

Vysis has generally objected to the document requests and interrogatories on the grounds that Gen-Probe is already in possession of the information or documents sought. *See* Objections and Responses to Plaintiff Gen-Probe Incorporated's First Set of Requests for Production of Documents, General Objection 3 ("Vysis Responses To Document Requests"). We are unaware of what information you believe that Gen-Probe already possesses. Thus, we cannot accept this objection as a basis to withhold from discovery any information or documents. Please confirm that no documents or information will be withheld on the basis of this objection.

Vysis and the third parties have narrowed the definition of the "'338 patent" that Gen-Probe set forth in its requests. *See e.g.* Vysis' Responses To Document Requests, General Objection 6. Please confirm that Vysis intends to provide discovery with respect to each of the patent applications and patents that trace their roots to the 922,155 application. Further, it appears that the responding parties have excepted from the scope of discovery the foreign applications and patents that are related to the '338 patent. We cannot accept this limitation and insist that Vysis provide full disclosure with respect to all such foreign applications. Please confirm that no documents are being withheld subject to this objection.

The third party witnesses have objected to producing all documents that refer to Vysis' relationship with BP Amoco and all documents that refer to investment by BP Amoco in Vysis. They have, however, offered to produce representative samples of such documents. *See e.g.* Banks' Subpoena Responses, Response 38. Without waiving its right to later pursue such discovery, Gen-Probe is amenable to accepting such a representative sample of these documents, provided that Vysis prepares and produces a list that describes the material elements of any and all investment by BP Amoco in Vysis or substantial agreements between BP Amoco and Vysis (i.e. partnership agreements, joint venture agreements, collaboration agreements, co-development agreements, licensing agreements, etc.) Please contact us to discuss further such an arrangement.

The third parties have objected to the definition of BP Amoco that Gen-Probe inserted into its subpoenas. *See e.g.* Banks' Subpoena Responses, General Objection 6. The responding parties have excluded from the definition of BP Amoco the following companies: Gene-Trak, Inc., Integrated Genetics, and Gene-Trak Systems Industrial Diagnostics Corporation. It is our understanding that BP Amoco has or had substantial relationships with or investment in these companies, such that BP Amoco was in a position to exercise control over them. Thus, we believe that they should be considered part of BP Amoco for purposes of discovery. If you believe that we are incorrect, please explain the basis for your position. Also, please identify whether documents in the possession, custody or control of BP Amoco are being withheld on this basis.

As a final point, please ensure that all documents that are withheld on the basis of any applicable privilege are identified in an appropriate privilege log.

Cooley Godward LLP

Thomas W. Banks, Esq.
August 3, 2000
Page Four

I sincerely hope that we can continue to work together to resolve these issues in an expeditious fashion. Please do not hesitate to contact us at your earliest convenience to discuss any of the issues identified above. Similarly, if I have misstated any aspect of our telephone conversation of Friday, July 28, 2000, please let me know.

Very sincerely,

Cooley Godward LLP


Patrick M. Maloney

PMM:lh

cc: Stephen P. Swinton, Esq.
Matthew Lehr, Esq.

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EXHIBIT G

6/20

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5 R. WILLIAM BOWEN, JR. (102178)
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9 Attorneys for Plaintiff
Gen-Probe Incorporated

10
11 UNITED STATES DISTRICT COURT
12 SOUTHERN DISTRICT OF CALIFORNIA
13

14 GEN-PROBE INCORPORATED,
15 Plaintiff,
16 v.
17 VYSIS, INC.,
18 Defendant.

No. 99cv2668 H (AJB)

GEN-PROBE INCORPORATED'S RESPONSES TO
VYSIS, INC.'S SECOND SET OF REQUESTS FOR
PRODUCTION OF DOCUMENTS

19
20 PROPOUNDING PARTY: DEFENDANT VYSIS, INC.

21 RESPONDING PARTY: PLAINTIFF GEN-PROBE INCORPORATED

22 SET NUMBER: TWO (2)

23 Pursuant to Federal Rule of Civil Procedure 34, Plaintiff Gen-Probe Incorporated ("Gen-
24 Probe") responds as follows to defendant Vysis, Inc.'s second set of requests for production of
25 documents:

26 I. GENERAL RESPONSES.

27 1. Gen-Probe's response to defendant's first set of requests for production of documents is
28 made to the best of Gen-Probe's current employees' present knowledge, information, and belief.

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1 Said response is at all times subject to such additional or different information that discovery or
2 further investigation may disclose and, while based on the present state of Gen-Probe's
3 recollection, is subject to such refreshing of recollection, and such additional knowledge of facts,
4 as may result from its further discovery or investigation.

5 2. Gen-Probe reserves the right to make any use of, or to introduce at any hearing and at
6 trial, documents responsive to defendant's first request for production but discovered subsequent
7 to the date of Gen-Probe's initial production, including, but not limited to, any documents obtained
8 in discovery herein.

9 3. Gen-Probe will respond to each document request with documents currently in Gen-
10 Probe's possession, custody and control. By stating in these responses that Gen-Probe will
11 produce documents or is searching for documents, Gen-Probe does not represent that any
12 document actually exists, but rather that Gen-Probe will make a good faith search and attempt to
13 ascertain whether documents responsive to defendant's request do, in fact, exist.

14 4. To the extent that Gen-Probe responds to defendant's document requests by stating that
15 Gen-Probe will produce documents which it or any other party to this litigation deems to embody
16 material that is private, business confidential, proprietary, trade secret or otherwise protected from
17 disclosure pursuant to Federal Rule of Civil Procedure 26(c)(7), Federal Rule of Evidence 501,
18 California Evidence Code section 1060, California Constitution, Article I, section 1, or any like or
19 similar law of any jurisdiction, Gen-Probe will do so only upon the entry of an appropriate
20 protective order.

21 5. Gen-Probe reserves the right to decide whether the documents produced for inspection
22 shall be produced as they are kept in the usual course of business or shall be organized and labeled
23 to correspond with the categories in defendant's request, in accordance with Federal Rule of Civil
24 Procedure 34(b).

25 6. Gen-Probe reserves all objections or other questions as to the competency, relevance,
26 materiality, privilege or admissibility as evidence in any subsequent proceeding in or trial of this or
27 any other action for any purpose whatsoever of this response and any document or thing produced
28 in response to defendant's request.

7. Gen-Probe reserves the right to object on any ground at any time to such other or supplemental requests for production as defendant may at any time propound involving or relating to the subject matter of these requests.

8. Subject to all objections, privileges and other exceptions stated herein, Gen-Probe shall produce the documents requested in defendant's second request for production of documents at the offices of its counsel, Cooley, Godward LLP, 4365 Executive Drive, 12th Floor, San Diego, California, after an appropriate protective order has been entered.

II. GENERAL OBJECTIONS.

1. Gen-Probe makes the following general objections, whether or not separately set forth in response to each document request, to each and every instruction, definition, and document request made in defendant's first request for production of documents:

2. Gen-Probe objects generally to Request 2 through 48, insofar as any of them seeks production of documents or information protected by the attorney-client privilege or the attorney work product privilege. Such documents or information shall not be produced in response to defendant's request, and any inadvertent production thereof shall not be deemed a waiver of any privilege with respect to such documents or information or of any work product doctrine, which may attach thereto.

3. Gen-Probe objects to the introductory definitions and instructions to defendant's document request to the extent said definitions or instructions purport to enlarge, expand, or alter in any way the plain meaning and scope of any specific request on the ground that such enlargement, expansion, or alteration renders said request vague, ambiguous, unintelligible, unduly broad, and uncertain.

4. Gen-Probe objects to all instructions, definitions and document requests to the extent they seek documents not currently in Gen-Probe's possession, custody or control, or refer to persons, entities or events not known to Gen-Probe, on the grounds that such instructions, definitions, or requests seek to require more instructions, definitions, or requests seek to require more of Gen-Probe than any obligation imposed by law, would subject Gen-Probe to unreasonable and undue annoyance, oppression, burden, and expense, and would seek to impose upon Gen-

1 Probe an obligation to investigate or discover information or materials from third parties or sources
2 who are equally accessible to defendant.

3 5. Gen-Probe objects to all definitions, instructions, and document requests in which the
4 phrase "relate to" or "relating to" appears. The terms "relate to" and "relating to" are overly
5 broad, vague, ambiguous, and unintelligible, require subjective judgment on the part of Gen-Probe
6 and Gen-Probe attorneys, and would require a conclusion or opinion of counsel in violation of the
7 attorney work product doctrine. Without waiving this objection, and subject to all other applicable
8 objections or privileges stated herein, Gen-Probe will produce, in response to any request for
9 documents that "relate" to a given subject, such documents as expressly reflect or refer on their
10 face to information relevant to the specified subject.

11 6. Gen-Probe objects to Definition C to the extent it defines "Gen-Probe" to include Gen-
12 Probe's predecessors or successors; past or present divisions, subsidiaries, parents, or affiliates of
13 any of the foregoing entities; past or present joint ventures, partnerships, or limited partnerships of
14 which any of the foregoing entities is a joint venturer or a limited or general partner; and past or
15 present directors, officers, employees, agents, or representatives of any of the foregoing entities.
16 Said definition is vague and ambiguous in that it cannot be determined what is meant by the term
17 "Gen-Probe." Said definition is also overly broad, seeks irrelevant information not calculated to
18 lead to the discovery of admissible evidence, and would subject Gen-Probe and the other entities
19 identified in the definition to unreasonable and undue annoyance, oppression, burden and expense.

20 7. Gen-Probe objects to Definition H to the extent that it defines the terms "product,"
21 "products," "process" and "processes" in such a manner that they are interchangeable with one
22 another and to the extent that said definition embraces products and processes other than those
23 described in the operative pleading.

24 8. Gen-Probe further objects to Definition I to the extent that it defines the phrase "target
25 capture" more broadly than technology taught by the '338 patent.

26 9. Gen-Probe objects to the Definitions, Instructions, and prefatory statement, on the
27 ground that they seek unilaterally to impose an obligation to provide supplemental information
28 greater than that required by the Federal Rules of Civil Procedure and would subject Gen-Probe to

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1 unreasonable and undue annoyance, oppression, burden, and expense.

2 10. Gen-Probe objects to the statement in Instructions A and C and Definition C to the
3 extent they seek to require Gen-Probe to search for information about documents no longer in
4 existence or in Gen-Probe's possession, custody or control, on the grounds that said instruction is
5 overly broad, would subject Gen-Probe to undue annoyance, oppression, burden, and expense, and
6 seeks to impose upon Gen-Probe an obligation to investigate information or materials from third
7 parties or services who are equally accessible to defendant.

8 11. Gen-Probe objects to Instruction A to the extent it seeks to require it to identify
9 anything other than the specific claim of privilege or work product being made and the grounds for
10 such claim, on the ground that defendant's requests encompass potentially thousands of pages of
11 documents stored at Gen-Probe and possibly other locations, not all of which have as yet been
12 identified or reviewed by counsel. Accordingly, said instruction would subject Gen-Probe to
13 unreasonable and undue annoyance, oppression, burden, and expense, and seeks information
14 protected from discovery by privilege and as work product. Without waiving this objection and
15 subject to all other objections, privileges and exceptions set forth herein, Gen-Probe will identify
16 the date, author, and recipient(s) of each document withheld on the basis of privilege or work
17 product.

18 **III. SPECIFIC OBJECTIONS AND RESPONSES TO DOCUMENT REQUESTS.**

19 Without waiving or limiting in any manner any of the foregoing General Objections, but
20 rather incorporating them into each of the following responses to the extent applicable, Gen-Probe
21 responds to the specific requests of defendant's first request for production of documents as
22 follows:

23 **DOCUMENT REQUEST NO. 2:**

24 All documents referred to in, relied on in preparing, or relating to the subject matter of
25 Gen-Probe's Responses to Vysis's Interrogatories 3-9 to Gen-Probe.

26 **RESPONSE TO DOCUMENT REQUEST NO. 2:**

27 Gen-Probe incorporates into this response each of the foregoing General Responses and
28 General Objections as if fully set forth herein. Gen-Probe further incorporates, as if fully set forth

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1 herein, each of the objections, Gen-Probe set forth in its responses to interrogatories 3 - 9, to the
2 extent that this request incorporates those interrogatories by reference. Gen-Probe further objects
3 to producing documents responsive to that portion of the request seeking documents "relied on in
4 preparing, or relating to the subject matter of Gen-Probe's Responses to Vysis's Interrogatories 3-9
5 to Gen-Probe" on the ground that such request expressly calls for the production of work product
6 or other privileged information. Gen-Probe also objects that the term "subject matter of Gen-
7 Probe's response" is vague and overbroad. Without waiving, and subject to, the foregoing
8 objections, Gen-Probe will produce all non-privileged documents in its possession, custody and
9 control to which it refers in its responses to Vysis's Interrogatories 3-9.

10 **DOCUMENT REQUEST NO. 3:**

11 All documents relating to, referring to, or describing any product or process for detecting
12 and/or quantifying a polynucleotide using target capture and amplification developed by Gen-
13 Probe, either by itself or with another person, including but not limited to Gen-Probe's NAT test
14 kits for use in detecting HCV or HIV.

15 **RESPONSE TO DOCUMENT REQUEST NO. 3:**

16 Gen-Probe incorporates into this response each of the foregoing General Responses and
17 General Objections as if fully set forth herein. Gen-Probe further objects that this request is vague
18 and ambiguous with respect to the term "amplification." Gen-Probe also objects that to the extent
19 this request seeks documents relating to products other than Gen-Probe's NAT test kits for use in
20 detecting HCV or HIV, the request is overbroad, unduly burdensome and is not reasonably
21 calculated to lead to the discovery of admissible evidence. Even as to Gen-Probe's NAT test kits
22 for use in detecting HCV or HIV, Gen-Probe objects that Vysis' demand for the production of "all
23 documents relating to, referring to, or describing" such products is overbroad and burdensome.
24 Without waiving, and subject to, the foregoing objections, Gen-Probe will produce a complete set
25 of non-privileged, design specification documents concerning the design and method of operation
26 of such products.

27 **DOCUMENT REQUEST NO. 4:**

28 All documents constituting, referring to, or relating to instructions and/or manuals for any

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product or process for detecting and/or quantifying a polynucleotide using target capture and amplification developed by Gen-Probe, either by itself or with another person, including but not limited to Gen-Probe's NAT test kits for use in detecting HCV or HIV.

RESPONSE TO DOCUMENT REQUEST NO. 4:

Gen-Probe incorporates into this response each of the foregoing General Responses and General Objections as if fully set forth herein. Gen-Probe further objects that this request is vague and ambiguous with respect to the term "amplification." Gen-Probe also objects that to the extent this request seeks documents relating to products other than Gen-Probe's NAT test kits for use in detecting HCV or HIV, the request is overbroad, unduly burdensome and is not reasonably calculated to lead to the discovery of admissible evidence. Even as to Gen-Probe's NAT test kits for use in detecting HCV or HIV, Gen-Probe objects that Vysis' demand for the production of "all documents constituting, referring or relating to instructions and/or manuals" for such products is overbroad and burdensome. Without waiving, and subject to, the foregoing objections, Gen-Probe will produce a complete set of non-privileged, design specification documents concerning the design and method of operation of such products.

DOCUMENT REQUEST NO. 5:

All documents constituting, referring, or relating to product specifications for any product or process for detecting and/or quantifying a polynucleotide using target capture and amplification developed by Gen-Probe, either by itself or with another person, including but not limited to Gen-Probe's NAT test kits for use in detecting HCV or HIV.

RESPONSE TO DOCUMENT REQUEST NO. 5:

Gen-Probe incorporates into this response each of the foregoing General Responses and General Objections as if fully set forth herein. Gen-Probe further objects that this request is vague and ambiguous with respect to the term "amplification." Gen-Probe also objects that to the extent this request seeks documents relating to products other than Gen-Probe's NAT test kits for use in detecting HCV or HIV, the request is overbroad, unduly burdensome and is not reasonably calculated to lead to the discovery of admissible evidence. Even as to Gen-Probe's NAT test kits for use in detecting HCV or HIV, Gen-Probe objects that Vysis' demand for the production of "all

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documents constituting, referring or relating to product specifications" for such products is overbroad and burdensome. Without waiving, and subject to, the foregoing objections, Gen-Probe will produce a complete set of non-privileged, design specification documents concerning the design and method of operation of such products.

5 | DOCUMENT REQUEST NO. 6:

6 A sample of Gen-Probe's NAT test kits for use in detecting HCV and HIV.

7 | **RESPONSE TO DOCUMENT REQUEST NO. 6:**

8 Gen-Probe incorporates into this response each of the foregoing General Responses and
9 General Objections as if fully set forth herein. Without waiving, and subject to, the foregoing
10 objections, Gen-Probe will produce samples of its NAT test kits to an (1) an independent third
11 party (2) upon the parties' agreement or court order sufficient to invoke restrictions and conditions
12 appropriate to protect Gen-Probe's proprietary interests in these biological materials and ensure the
13 continued integrity of such samples.

14 | DOCUMENT REQUEST NO. 7:

15 All documents referring to, relating to, or describing the research, development,
16 manufacture, use or sale by Gen-Probe of any product or process for detecting and/or quantifying a
17 polynucleotide using target capture and amplification developed by Gen-Probe, either by itself or
18 with another person, including but not limited to Gen-Probe's NAT test kits for use in detecting
19 HCV or HIV.

20 **RESPONSE TO DOCUMENT REQUEST NO. 7:**

21 Gen-Probe incorporates into this response each of the foregoing General Responses and
22 General Objections as if fully set forth herein. Gen-Probe further objects that this request is vague
23 and ambiguous with respect to the term "amplification." Gen-Probe also objects that to the extent
24 this request seeks documents relating to products other than Gen-Probe's NAT test kits for use in
25 detecting HCV or HIV, the request is overbroad, unduly burdensome and is not reasonably
26 calculated to lead to the discovery of admissible evidence. Even as to Gen-Probe's NAT test kits
27 for use in detecting HCV or HIV, Gen-Probe objects that Vysis' demand for the production of "all
28 documents referring to, relating to, or describing the research, development, manufacture use or

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1 sale by Gen-Probe" of any such products is overbroad and burdensome. Without waiving, and
2 subject to, the foregoing objections, Gen-Probe will produce a complete set of non-privileged,
3 design specification documents concerning the design and method of operation of such products.

4 **DOCUMENT REQUEST NO. 8:**

5 All documents relating to, referring to, or describing any effort or attempt to design around
6 the '338 patent.

7 **RESPONSE TO DOCUMENT REQUEST NO. 8:**

8 Gen-Probe incorporates into this response each of the foregoing General Responses and
9 General Objections as if fully set forth herein. Gen-Probe further objects that this request is
10 overbroad, unduly burdensome, and is not reasonably calculated to lead to the discovery of
11 admissible evidence. Gen-Probe also objects that the term "design around" is vague and
12 ambiguous leaving Gen-Probe to guess as to its meaning. Without waiving, and subject to, the
13 foregoing objections, Gen-Probe states that it does not possess any non-privileged documents that
14 are responsive to this request.

15 **DOCUMENT REQUEST NO. 9:**

16 All documents relating to, referring to, or describing comparisons between Gen-Probe's
17 NAT test kits for use in detecting HCV or HIV and any potentially competing product or process
18 not within the scope of the claims of the '338 patent.

19 **RESPONSE TO DOCUMENT REQUEST NO. 9:**

20 Gen-Probe incorporates into this response each of the foregoing General Responses and
21 General Objections as if fully set forth herein. Gen-Probe further objects that the language
22 "potentially competing product or process not within the scope of the claims of the '338 patent" is
23 vague and ambiguous. Gen-Probe further objects that this request calls for legal conclusions
24 concerning the construction of the claims of the '338 patent and the products or processes that
25 Vysis contends are not within the claims of the '338 patent. Gen-Probe further objects that this
26 request is overbroad, unduly burdensome and is not reasonably calculated to lead to the discovery
27 of admissible evidence. Without waiving, and subject to, the foregoing objections, Gen-Probe will
28 produce a complete set of non-privileged, design specification documents concerning the design

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1 and method of operation of its NAT test kits for HCV and HIV.

2 **DOCUMENT REQUEST NO. 10:**

3 All documents referring or relating to the '338 patent or any related patent or application.

4 **RESPONSE TO DOCUMENT REQUEST NO. 10:**

5 Gen-Probe incorporates into this response each of the foregoing General Responses and
6 General Objections as if fully set forth herein. Gen-Probe further objects that the term "related
7 patent or application" is vague and ambiguous, leaving Gen-Probe to guess as to its meaning.
8 Without waiving, and subject to, the foregoing objections, Gen-Probe will produce all non-
9 privileged, responsive documents within its possession, custody, and control that refer to the '338
10 patent.

11 **DOCUMENT REQUEST NO. 11:**

12 All documents referring to, relating to, or describing any analysis or study of the '338
13 patent.

14 **RESPONSE TO DOCUMENT REQUEST NO. 11:**

15 Gen-Probe incorporates into this response each of the foregoing General Responses and
16 General Objections as if fully set forth herein. Without waiving, and subject to, the foregoing
17 objections, Gen-Probe will produce all non-privileged, responsive documents within its
18 possession, custody, and control.

19 **DOCUMENT REQUEST NO. 12:**

20 All documents that Gen-Probe believes support its contention that it does not infringe the
21 '338 patent.

22 **RESPONSE TO DOCUMENT REQUEST NO. 12:**

23 Gen-Probe incorporates into this response each of the foregoing General Responses and
24 General Objections as if fully set forth herein. Gen-Probe further objects that Vysis' request for all
25 documents "supporting" Gen-Probe's contentions expressly requires the disclosure of attorney
26 work product and privileged attorney client communications. Gen-Probe further objects to this
27 request to the extent that it prematurely seeks the facts and contentions that Gen-Probe will
28 advance at trial before the completion of investigation and discovery. In response to this request

and at present time, Gen-Probe will produce those documents that are also responsive to Vysis' document requests 1-3, 6, 9, 11, 16, 24 and 32 and respond to interrogatory 2. Upon satisfactory progress of discovery, Gen-Probe will produce all documents then within its possession, custody and control that are responsive to Vysis' requests for such contention discovery.

DOCUMENT REQUEST NO. 13:

All documents that Gen-Probe believes support its contention that the '338 patent is invalid.

RESPONSE TO DOCUMENT REQUEST NO. 13:

Gen-Probe incorporates into this response each of the foregoing General Responses and General Objections as if fully set forth herein. Gen-Probe further objects that Vysis' request for all documents "supporting" Gen-Probe's contentions expressly requires the disclosure of attorney work product and privileged attorney client communications. Gen-Probe further objects to this interrogatory to the extent that it prematurely seeks the facts and contentions that Gen-Probe will advance at trial before the completion of investigation and discovery. In response to this request and at present time, Gen-Probe will produce those documents that are also responsive to Vysis' document requests 1-3, 6, 9, 11, 16, 24, and 32 and respond to interrogatory 1. Upon satisfactory progress of discovery, Gen-Probe will produce all documents then within its possession, custody and control that are responsive to Vysis' requests for such contention discovery.

DOCUMENT REQUEST NO. 14:

All documents that Gen-Probe believes support its contention that the '338 patent is unenforceable, including each unenforceability contention advanced by Gen-Probe in briefing on Vysis' motion for a stay of these proceedings.

RESPONSE TO DOCUMENT REQUEST NO. 14:

Gen-Probe incorporates into this response each of the foregoing General Responses and General Objections as if fully set forth herein. Gen-Probe further objects that Vysis' request for all documents "supporting" Gen-Probe's contentions expressly requires the disclosure of attorney work product and privileged attorney client communications. Gen-Probe further objects to this interrogatory to the extent that it prematurely seeks the facts and contentions that Gen-Probe will

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1 advance at trial before the completion of investigation and discovery. In response to this request
2 and at present time, Gen-Probe will produce those documents that are also responsive to Vysis'
3 document requests 1-3, 6, 9, 11, 16, 24 and 32 and respond to interrogatories 1-3, 7, and 9. Upon
4 satisfactory progress of discovery, Gen-Probe will produce all documents then within its
5 possession, custody and control that are responsive to Vysis' requests for such contention
6 discovery.

7 **DOCUMENT REQUEST NO. 15:**

8 All documents on which Gen-Probe relies for its contention that the '338 patent is invalid
9 under 35 U.S.C. §§ 102 or 103.

10 **RESPONSE TO DOCUMENT REQUEST NO. 15:**

11 Gen-Probe incorporates into this response each of the foregoing General Responses and
12 General Objections as if fully set forth herein. Gen-Probe further objects that Vysis' request for all
13 documents "supporting" Gen-Probe's contentions expressly requires the disclosure of attorney
14 work product and privileged attorney client communications. Gen-Probe further objects to this
15 interrogatory to the extent that it prematurely seeks the facts and contentions that Gen-Probe will
16 advance at trial before the completion of investigation and discovery. In response to this request
17 and at present time, Gen-Probe will produce those documents that are also responsive to Vysis'
18 document requests 1-3, 6, 9, 11, 16, 24, and 32 and respond to interrogatory 1. Upon satisfactory
19 progress of discovery, Gen-Probe will produce all documents then within its possession, custody
20 and control that are responsive to Vysis' requests for such contention discovery.

21 **DOCUMENT REQUEST NO. 16:**

22 All documents referring to, relating to, constituting or describing prior art searches with
23 respect to the subject matter of the '338 patent or the results of such searches.

24 **RESPONSE TO DOCUMENT REQUEST NO. 16:**

25 Gen-Probe incorporates into this response each of the foregoing General Responses and
26 General Objections as if fully set forth herein. Gen-Probe further objects to this interrogatory to
27 the extent that it prematurely seeks the facts and contentions that Gen-Probe will advance at trial
28 before the completion of investigation and discovery. Gen-Probe further objects to this request to

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1 the extent that it the criteria employed when searching for prior art constitutes attorney work
2 product. Without waiving, and subject to, the foregoing objections, Gen-Probe will produce all
3 non-privileged, prior art references within its possession, custody, and control.

4 **DOCUMENT REQUEST NO. 17:**

5 All documents referring or relating to the scope, meaning, or construction of any claim of
6 the '338 patent.

7 **RESPONSE TO DOCUMENT REQUEST NO. 17:**

8 Gen-Probe incorporates into this response each of the foregoing General Responses and
9 General Objections as if fully set forth herein. Gen-Probe further objects that Vysis' request for all
10 documents referring or relating to the scope, meaning, or construction of any claim of the '338
11 patent expressly requires the disclosure of attorney work product and privileged attorney client
12 communications. Gen-Probe further objects to this interrogatory to the extent that it prematurely
13 seeks the facts and contentions that Gen-Probe will advance at trial before the completion of
14 investigation and discovery. In response to this request, at present time, and without waiving, and
15 subject to, the foregoing objections, Gen-Probe will produce those non-privileged documents that
16 are also responsive to Vysis' document requests 1-3, 6, 9, 11, 16, 24, and 32 and respond to
17 interrogatories 1 and 2. Upon satisfactory progress of discovery, Gen-Probe will produce all non-
18 privileged documents then within its possession, custody and control in response to this request.

19 **DOCUMENT REQUEST NO. 18:**

20 All documents referring to, relating to, or constituting any infringement, non-infringement,
21 validity, invalidity, enforceability, or unenforceability analysis of the '338 patent.

22 **RESPONSE TO DOCUMENT REQUEST NO. 18:**

23 Gen-Probe incorporates into this response each of the foregoing General Responses and
24 General Objections as if fully set forth herein. Without waiving, and subject to, the foregoing
25 objections, Gen-Probe states that it does not possess any non-privileged documents that are
26 responsive to this request.

27 **DOCUMENT REQUEST NO. 19:**

28 All documents referring to, relating to, or describing any decision about whether to obtain a

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1 legal opinion relating to the '338 patent.

2 **RESPONSE TO DOCUMENT REQUEST NO. 19:**

3 Gen-Probe incorporates into this response each of the foregoing General Responses and
4 General Objections as if fully set forth herein. Gen-Probe further objects that the term "legal
5 opinion" is vague and ambiguous leaving Gen-Probe to guess as to its meaning. Without waiving,
6 and subject to, the foregoing objections, Gen-Probe states that it does not possess any non-
7 privileged documents that are responsive to this request.

8 **DOCUMENT REQUEST NO. 20:**

9 All documents referring to, relating to, describing, or constituting procedures, policies,
10 guidelines, training materials, or recommended courses of action concerning third-party patents.

11 **RESPONSE TO DOCUMENT REQUEST NO. 20:**

12 Gen-Probe incorporates into this response each of the foregoing General Responses and
13 General Objections as if fully set forth herein. Gen-Probe further objects that this request is
14 overbroad, unduly burdensome and is not reasonably calculated to lead to the discovery of
15 admissible evidence. Without waiving, and subject to, the foregoing objections, Gen-Probe states
16 that it does not possess any non-privileged documents that are responsive to this request.

17 **DOCUMENT REQUEST NO. 21:**

18 All documents referring to, relating to, or describing the use or prospective use of any
19 teaching contained in the '338 patent in the design or development of any product or process for
20 detecting and/or quantifying a polynucleotide using target capture and amplification developed by
21 Gen-Probe, either by itself or with another person, including but not limited to Gen-Probe NAT
22 test kit for use in detecting HCV or HIV.

23 **RESPONSE TO DOCUMENT REQUEST NO. 21:**

24 Gen-Probe incorporates into this response each of the foregoing General Responses and
25 General Objections as if fully set forth herein. Gen-Probe further objects that this request is vague
26 and ambiguous with respect to the terms "amplification" and "teaching." Gen-Probe further
27 objects that this request is phrased in an argumentative manner that assumes facts not in evidence.
28 Gen-Probe still further objects that this request requires Gen-Probe to guess as to the "teaching"

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1 purportedly contained in the '338 patent. Gen-Probe also objects that to the extent this request
2 seeks documents relating to products other than Gen-Probe's NAT test kits for use in detecting
3 HCV or HIV, the request is overbroad, unduly burdensome and is not reasonably calculated to lead
4 to the discovery of admissible evidence. Even as to Gen-Probe's NAT test kits for use in detecting
5 HCV or HIV, Gen-Probe objects that Vysis' demand for the production of "all documents
6 referring to, relating to, or describing the use or prospective use of any teaching contained in the
7 '338 patent" is overbroad and burdensome. Without waiving, and subject to, the foregoing
8 objections, and without any agreement or acknowledgement as to the "teaching" of the '338 patent
9 or the use or prospective use of the same, Gen-Probe will produce a complete set of non-
10 privileged, design specification documents concerning the design and method of operation of such
11 products.

12 **DOCUMENT REQUEST NO. 22:**

13 All documents referring to, relating to, or describing the circumstances under which Gen-
14 Probe first became aware of the '338 patent.

15 **RESPONSE TO DOCUMENT REQUEST NO. 22:**

16 Gen-Probe incorporates into this response each of the foregoing General Responses and
17 General Objections as if fully set forth herein. Gen-Probe further objects that this request is
18 overbroad, unduly burdensome and is not reasonably calculated to lead to the discovery of
19 admissible evidence. Without waiving, and subject to, the foregoing objections, Gen-Probe
20 produce all non-privileged, responsive documents within its possession, custody and control.

21 **DOCUMENT REQUEST NO. 23:**

22 All documents referring to, relating to, or describing products or processes for detecting
23 and/or quantifying a polynucleotide using target capture and amplification developed by Gen-
24 Probe, either by itself or with another person, including but not limited to all documents referring
25 to, relating to, describing or constituting a study or analysis of those products or processes in
26 relation to the '338 patent.

27 **RESPONSE TO DOCUMENT REQUEST NO. 23:**

28 Gen-Probe incorporates into this response each of the foregoing General Responses and

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1 General Objections as if fully set forth herein. Gen-Probe further objects that this request is vague
2 and ambiguous with respect to the term "amplification." Gen-Probe also objects that to the extent
3 this request seeks documents relating to products other than Gen-Probe's NAT test kits for use in
4 detecting HCV or HIV, the request is overbroad, unduly burdensome and is not reasonably
5 calculated to lead to the discovery of admissible evidence. Even as to Gen-Probe's NAT test kits
6 for use in detecting HCV or HIV, Gen-Probe objects that Vysis' demand for the production of "all
7 documents referring to, relating to, or describing products or processes for detecting and/or
8 quantifying a polynucleotide using target capture and amplification developed by Gen-Probe" is
9 overbroad and burdensome. Without waiving, and subject to, the foregoing objections, Gen-Probe
10 will produce a complete set of non-privileged, design specification documents concerning the
11 design and method of operation of such products.

12 **DOCUMENT REQUEST NO. 24:**

13 All documents referring to, relating to, describing or constituting communications between
14 Gen-Probe and third parties regarding the '338 patent.

15 **RESPONSE TO DOCUMENT REQUEST NO. 24:**

16 Gen-Probe incorporates into this response each of the foregoing General Responses and
17 General Objections as if fully set forth herein. Gen-Probe further objects that this request is
18 overbroad, unduly burdensome and is not reasonably calculated to lead to the discovery of
19 admissible evidence. Gen-Probe further objects that this request seeks documents that may be
20 protected by the confidentiality interests of third parties and may also be protected by joint and
21 several interests in applicable attorney-client privileged communications and attorney work
22 product. Without waiving, and subject to, the foregoing objections, Gen-Probe will produce all
23 non-privileged, responsive documents within its possession, custody, and control that refer both to
24 the '338 patent and Gen-Probe's NAT test kits for HCV and HIV.

25 **DOCUMENT REQUEST NO. 25:**

26 All documents referring to, relating to, describing or constituting communications between
27 Gen-Probe and third parties regarding any product or process for detecting and/or quantifying a
28 polynucleotide using target capture and amplification developed by Gen-Probe, either by itself or

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1 with another person, including but not limited to Gen-Probe's NAT test kits for use in detecting
2 HCV or HIV.

3 **RESPONSE TO DOCUMENT REQUEST NO. 25:**

4 Gen-Probe incorporates into this response each of the foregoing General Responses and
5 General Objections as if fully set forth herein. Gen-Probe further objects that this request seeks
6 documents that may be protected by the confidentiality interests of third parties. Gen-Probe also
7 objects that to the extent this request seeks documents relating to products other than Gen-Probe's
8 NAT test kits for use in detecting HCV or HIV, the request is overbroad, unduly burdensome and
9 is not reasonably calculated to lead to the discovery of admissible evidence. Gen-Probe further
10 objects that this request is vague and ambiguous with respect to the term "amplification." Without
11 waiving, and subject to, the foregoing objections, Gen-Probe will produce any non-privileged,
12 responsive documents within its possession, custody, and control.

13 **DOCUMENT REQUEST NO. 26:**

14 All documents referring to, relating to, describing or constituting communications between
15 Gen-Probe and third parties relating to this litigation.

16 **RESPONSE TO DOCUMENT REQUEST NO. 26:**

17 Gen-Probe incorporates into this response each of the foregoing General Responses and
18 General Objections as if fully set forth herein. Gen-Probe further objects that this request seeks
19 documents that may be protected by the confidentiality interests of third parties and may also be
20 protected by community of interests in applicable attorney-client privileged communications and
21 attorney work product. Furthermore, Gen-Probe objects to producing or identifying
22 communications occurring after the initiation of the litigation between it and third parties
23 concerning this litigation on the grounds of the attorney-client privilege and attorney work product.
24 Without waiving, and subject to, the foregoing objections, Gen-Probe states that it does not
25 possess any non-privileged documents responsive to this request that pre-date this litigation.

26 **DOCUMENT REQUEST NO. 27:**

27 All documents referring to, relating to, or describing the need for or desirability of Gen-
28 Probe's taking a license under the '338 patent, or Gen-Probe's decision regarding whether or not to

1 take a license under the '338 patent.

2 **RESPONSE TO DOCUMENT REQUEST NO. 27:**

3 Gen-Probe incorporates into this response each of the foregoing General Responses and
4 General Objections as if fully set forth herein. Without waiving, and subject to, the foregoing
5 objections, Gen-Probe states that it does not possess any non-privileged documents that are
6 responsive to this request.

7 **DOCUMENT REQUEST NO. 28:**

8 All documents referring to, relating to, or describing Gen-Probe's decision whether or not
9 to institute this action against Vysis.

10 **RESPONSE TO DOCUMENT REQUEST NO. 28:**

11 Gen-Probe incorporates into this response each of the foregoing General Responses and
12 General Objections as if fully set forth herein. Without waiving, and subject to, the foregoing
13 objections, Gen-Probe states that it does not possess any non-privileged documents that are
14 responsive to this request.

15 **DOCUMENT REQUEST NO. 29:**

16 All documents Gen-Probe believes support its unfair competition claim.

17 **RESPONSE TO DOCUMENT REQUEST NO. 29:**

18 Gen-Probe further objects to this request to the extent that it calls for the disclosure of
19 attorney work product. Gen-Probe further objects that Vysis' requests that seek all documents
20 "supporting" Gen-Probe's contentions expressly requires the disclosure of attorney work product
21 and privileged attorney client communications. Gen-Probe further objects to this request to the
22 extent that it prematurely seeks the facts and contentions that Gen-Probe will advance at trial
23 before the completion of investigation and discovery. Upon satisfactory progress of discovery,
24 Gen-Probe will agree to produce all non-privileged documents responsive to Vysis' request.
25 Without waiving and subject to the foregoing objections, Gen-Probe will produce documents
26 responsive to Vysis' requests document requests 1-3, 6, 9, 11, 16, 24 and 32, and interrogatories 1-
27 3, 7, and 9.

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1 **DOCUMENT REQUEST NO. 30:**

2 Documents sufficient to describe the corporate and organizational structure of Gen-Probe
3 Incorporated for each year since 1990.

4 **RESPONSE TO DOCUMENT REQUEST NO. 30:**

5 Gen-Probe incorporates into this response each of the foregoing General Responses and
6 General Objections as if fully set forth herein. Without waiving, and subject to, the foregoing
7 objections, Gen-Probe will produce documents that describe its corporate and organizational
8 structure.

9 **DOCUMENT REQUEST NO. 31:**

10 Documents sufficient to identify all employees, attorneys, officers, consultants or other
11 persons involved in the research, development, testing, evaluation, manufacture, marketing, sale,
12 or servicing of any product or process for detecting and/or quantifying a polynucleotide using
13 target capture and amplification developed by Gen-Probe, either by itself or with another person,
14 including but not limited to Gen-Probe's NAT test kits for use in detecting HCV or HIV.

15 **RESPONSE TO DOCUMENT REQUEST NO. 31:**

16 Gen-Probe incorporates into this response each of the foregoing General Responses and
17 General Objections as if fully set forth herein. Gen-Probe also objects that to the extent this
18 request seeks documents relating to products other than Gen-Probe's NAT test kits for use in
19 detecting HCV or HIV, the request is overbroad, unduly burdensome and is not reasonably
20 calculated to lead to the discovery of admissible evidence. Gen-Probe further objects that this
21 request is vague and ambiguous with respect to the term "amplification." Without waiving, and
22 subject to, the foregoing objections, Gen-Probe will prepare and produce a list identifying the
23 persons principally involved with Gen-Probe's NAT test kits for detecting HCV and HIV.

24 **DOCUMENT REQUEST NO. 32:**

25 All documents relating to correspondence or communications between Gen-Probe and
26 Vysis relating to the '338 patent or any product or process for detecting and/or quantifying a
27 polynucleotide using target capture and amplification developed by Gen-Probe, either by itself or
28 with another person, including but not limited to Gen-Probe's NAT test kits for use in detecting

1 HCV or HIV.

2 **RESPONSE TO DOCUMENT REQUEST NO. 32:**

3 Gen-Probe incorporates into this response each of the foregoing General Responses and
4 General Objections as if fully set forth herein. Gen-Probe also objects that to the extent this request
5 seeks documents relating to products other than Gen-Probe's NAT test kits for use in detecting
6 HCV or HIV, the request is overbroad, unduly burdensome and is not reasonably calculated to lead
7 to the discovery of admissible evidence. Gen-Probe further objects that this request is vague and
8 ambiguous with respect to the term "amplification." Without waiving, and subject to, the
9 foregoing objections, Gen-Probe will produce all non-privileged, responsive documents in its
10 possession, custody and control that refer both to the '338 patent and Gen-Probe's NAT test kits
11 for HCV and HIV.

12 **DOCUMENT REQUEST NO. 33:**

13 All documents referring to, relating to, describing or constituting offers for sale of any
14 product or process for detecting and/or quantifying a polynucleotide using target capture and
15 amplification developed by Gen-Probe, either by itself or with another person, including but not
16 limited to Gen-Probe's NAT test kits for use in detecting HCV or HIV.

17 **RESPONSE TO DOCUMENT REQUEST NO. 33:**

18 Gen-Probe incorporates into this response each of the foregoing General Responses and
19 General Objections as if fully set forth herein. Gen-Probe further objects that this request is vague
20 and ambiguous with respect to the term "amplification." Gen-Probe also objects that to the extent
21 this request seeks documents relating to products other than Gen-Probe's NAT test kits for use in
22 detecting HCV or HIV, the request is overbroad, unduly burdensome and is not reasonably
23 calculated to lead to the discovery of admissible evidence. Even as to Gen-Probe's NAT test kits
24 for use in detecting HCV or HIV, the request is overbroad, unduly burdensome and is not
25 reasonably calculated to lead to the discovery of admissible evidence. Without waiving, and
26 subject to, the foregoing objections, Gen-Probe will produce all of the non-privileged books and
27 records otherwise available to Vysis under paragraph 3.9 of the parties' license agreement.

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DOCUMENT REQUEST NO. 34:

All documents referring to, relating to, describing or constituting sales of any product or process for detecting and/or quantifying a polynucleotide using target capture and amplification developed by Gen-Probe, either by itself or with another person, including but not limited to Gen-Probe's NAT test kits for use in detecting HCV or HIV.

RESPONSE TO DOCUMENT REQUEST NO. 34:

Gen-Probe incorporates into this response each of the foregoing General Responses and General Objections as if fully set forth herein. Gen-Probe further objects that this request is vague and ambiguous with respect to the term "amplification." Gen-Probe also objects that to the extent this request seeks documents relating to products other than Gen-Probe's NAT test kits for use in detecting HCV or HIV, the request is overbroad, unduly burdensome and is not reasonably calculated to lead to the discovery of admissible evidence. Even as to Gen-Probe's NAT test kits for use in detecting HCV or HIV, the request is overbroad, unduly burdensome and is not reasonably calculated to lead to the discovery of admissible evidence. Without waiving, and subject to, the foregoing objections, Gen-Probe will produce all of the non-privileged books and records otherwise available to Vysis under paragraph 3.9 of the parties' license agreement.

DOCUMENT REQUEST NO. 35:

All documents referring to, relating to, or describing the price of any product or process for detecting and/or quantifying a polynucleotide using target capture and amplification developed by Gen-Probe, either by itself or with another person, including but not limited to Gen-Probe's NAT test kits for use in detecting HCV or HIV.

RESPONSE TO DOCUMENT REQUEST NO. 35:

Gen-Probe incorporates into this response each of the foregoing General Responses and General Objections as if fully set forth herein. Gen-Probe further objects that this request is vague and ambiguous with respect to the term "amplification." Gen-Probe also objects that to the extent this request seeks documents relating to products other than Gen-Probe's NAT test kits for use in detecting HCV or HIV, the request is overbroad, unduly burdensome and is not reasonably calculated to lead to the discovery of admissible evidence. Even as to Gen-Probe's NAT test kits

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1 for use in detecting HCV or HIV, the request is overbroad, unduly burdensome and is not
2 reasonably calculated to lead to the discovery of admissible evidence. Without waiving, and
3 subject to, the foregoing objections, Gen-Probe will produce all of the non-privileged books and
4 records otherwise available to Vysis under paragraph 3.9 of the parties' license agreement.

5 **DOCUMENT REQUEST NO. 36:**

6 All documents referring to, relating to, or describing the costs associated with any product
7 or process for detecting and/or quantifying a polynucleotide using target capture and amplification
8 developed by Gen-Probe, either by itself or with another person, including but not limited to Gen-
9 Probe's NAT test kits for use in detecting HCV or HIV.

10 **RESPONSE TO DOCUMENT REQUEST NO. 36:**

11 Gen-Probe incorporates into this response each of the foregoing General Responses and
12 General Objections as if fully set forth herein. Gen-Probe further objects that this request is vague
13 and ambiguous with respect to the term "amplification." Gen-Probe also objects that to the extent
14 this request seeks documents relating to products other than Gen-Probe's NAT test kits for use in
15 detecting HCV or HIV, the request is overbroad, unduly burdensome and is not reasonably
16 calculated to lead to the discovery of admissible evidence. Even as to Gen-Probe's NAT test kits
17 for use in detecting HCV or HIV, the request is overbroad, unduly burdensome and is not
18 reasonably calculated to lead to the discovery of admissible evidence. Without waiving, and
19 subject to, the foregoing objections, Gen-Probe will produce all of the non-privileged books and
20 records otherwise available to Vysis under paragraph 3.9 of the parties' license agreement.

21 **DOCUMENT REQUEST NO. 37:**

22 All documents referring to, relating to, or describing the profits (gross and net) made on the
23 sale of any product or process for detecting and/or quantifying a polynucleotide using target
24 capture and amplification developed by Gen-Probe, either by itself or with another person,
25 including but not limited to Gen-Probe's NAT test kits for use in detecting HCV or HIV.

26 **RESPONSE TO DOCUMENT REQUEST NO. 37:**

27 Gen-Probe incorporates into this response each of the foregoing General Responses and
28 General Objections as if fully set forth herein. Gen-Probe further objects that this request is vague

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1 and ambiguous with respect to the term "amplification." Gen-Probe also objects that to the extent
2 this request seeks documents relating to products other than Gen-Probe's NAT test kits for use in
3 detecting HCV or HIV, the request is overbroad, unduly burdensome and is not reasonably
4 calculated to lead to the discovery of admissible evidence. Even as to Gen-Probe's NAT test kits
5 for use in detecting HCV or HIV, the request is overbroad, unduly burdensome and is not
6 reasonably calculated to lead to the discovery of admissible evidence. Without waiving, and
7 subject to, the foregoing objections, Gen-Probe will produce all of the non-privileged books and
8 records otherwise available to Vysis under paragraph 3.9 of the parties' license agreement.

9 **DOCUMENT REQUEST NO. 38:**

10 All documents referring to, relating to, or describing any licenses, agreements, or contracts
11 involving any product or process for detecting and/or quantifying a polynucleotide using target
12 capture and amplification developed by Gen-Probe, either by itself or with another person,
13 including but not limited to Gen-Probe's NAT test kits for use in detecting HCV or HIV.

14 **RESPONSE TO DOCUMENT REQUEST NO. 38:**

15 Gen-Probe incorporates into this response each of the foregoing General Responses and
16 General Objections as if fully set forth herein. Gen-Probe also objects that to the extent this request
17 seeks documents relating to products other than Gen-Probe's NAT test kits for use in detecting
18 HCV or HIV, the request is overbroad, unduly burdensome and is not reasonably calculated to lead
19 to the discovery of admissible evidence. Gen-Probe further objects that this request is vague and
20 ambiguous with respect to the term "amplification." Without waiving, and subject to, the
21 foregoing objections, Gen-Probe will produce a copy of the license and collaboration agreements
22 with Chiron and Bayer concerning Gen-Probe's NAT test kits for use in detecting HCV and HIV.

23 **DOCUMENT REQUEST NO. 39:**

24 All documents referring to, relating to, or describing any payments paid or received in
25 relation to any product or process for detecting and/or quantifying a polynucleotide using target
26 capture and amplification developed by Gen-Probe, either by itself or with another person,
27 including but not limited to Gen-Probe's NAT test kits for use in detecting HCV or HIV.

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1 **RESPONSE TO DOCUMENT REQUEST NO. 39:**

2 Gen-Probe incorporates into this response each of the foregoing General Responses and
3 General Objections as if fully set forth herein. Gen-Probe further objects that this request is vague
4 and ambiguous with respect to the term "amplification." Gen-Probe also objects that to the extent
5 this request seeks documents relating to products other than Gen-Probe's NAT test kits for use in
6 detecting HCV or HIV, the request is overbroad, unduly burdensome and is not reasonably
7 calculated to lead to the discovery of admissible evidence. Even as to Gen-Probe's NAT test kits
8 for use in detecting HCV or HIV, the request is overbroad, unduly burdensome and is not
9 reasonably calculated to lead to the discovery of admissible evidence. Without waiving, and
10 subject to, the foregoing objections, Gen-Probe will produce all of the non-privileged books and
11 records otherwise available to Vysis under paragraph 3.9 of the parties' license agreement.

12 **DOCUMENT REQUEST NO. 40:**

13 All documents referring to, relating to, describing or constituting business plans, marketing
14 plans or studies, and projections for any product or process for detecting and/or quantifying a
15 polynucleotide using target capture and amplification developed by Gen-Probe, either by itself or
16 with another person, including but not limited to Gen-Probe's NAT test kits for use in detecting
17 HCV or HIV.

18 **RESPONSE TO DOCUMENT REQUEST NO. 40:**

19 Gen-Probe incorporates into this response each of the foregoing General Responses and
20 General Objections as if fully set forth herein. Gen-Probe also objects that to the extent this
21 request seeks documents relating to products other than Gen-Probe's NAT test kits for use in
22 detecting HCV or HIV, the request is overbroad, unduly burdensome and is not reasonably
23 calculated to lead to the discovery of admissible evidence. Gen-Probe further objects that this
24 request is overbroad, unduly burdensome and is not reasonably calculated to lead to the discovery
25 of admissible evidence. Gen-Probe further objects that this request is vague and ambiguous with
26 respect to the term "amplification." Without waiving, and subject to, the foregoing objections,
27 Gen-Probe will produce all non-privileged marketing plans concerning Gen-Probe's NAT test kits
28 for use in detecting HCV and HIV.

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1 **DOCUMENT REQUEST NO. 41:**

2 All documents referring to, relating to, describing or constituting patents or applications,
3 U.S. or foreign, owned by or applied for by Gen-Probe, or employees thereof, relating to a product
4 or process for detecting and/or quantifying a polynucleotide using target capture and amplification,
5 including but not limited to, invention disclosures, evaluations of patentability, patent applications
6 and drafts thereof, file wrappers, prosecution histories, and other papers prepared during the course
7 of the prosecution of any such application.

8 **RESPONSE TO DOCUMENT REQUEST NO. 41:**

9 Gen-Probe incorporates into this response each of the foregoing General Responses and
10 General Objections as if fully set forth herein. Gen-Probe also objects that to the extent this
11 request seeks documents relating to products other than Gen-Probe's NAT test kits for use in
12 detecting HCV or HIV, the request is overbroad, unduly burdensome and is not reasonably
13 calculated to lead to the discovery of admissible evidence. Gen-Probe further objects that this
14 request is unduly burdensome to the extent that the information sought is publicly available to
15 Vysis. Gen-Probe further objects that this request is vague and ambiguous with respect to the term
16 "amplification." Without waiving, and subject to, the foregoing objections, Gen-Probe will
17 produce all responsive, non-privileged documents within its possession, custody and control that
18 refer to or constitute patents or patent applications that claim the inventions that may encompass
19 all or a portion of Gen-Probe's NAT test kits for use in detecting HCV and HIV.

20 **DOCUMENT REQUEST NO. 42:**

21 Documents sufficient to identify any assay made, used, offered for sale, or sold by Gen-
22 Probe for detecting and/or quantifying a polynucleotide using target capture and amplification,
23 other than Gen-Probe's NAT test kits for use in detecting HCV or HIV.

24 **RESPONSE TO DOCUMENT REQUEST NO. 42:**

25 Gen-Probe incorporates into this response each of the foregoing General Responses and
26 General Objections as if fully set forth herein. Gen-Probe further objects that this request is vague
27 and ambiguous with respect to the term "amplification." Gen-Probe further objects that this
28 request is overbroad, unduly burdensome and is not reasonably calculated to lead to the discovery

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of admissible evidence. Without waiving and subject to the foregoing objections, Gen-Probe will produce a complete set of non-privileged, design specification documents concerning the design and method of operation of Gen-Probe's NAT test kits for use in detecting HCV or HIV.

DOCUMENT REQUEST NO. 43:

All documents relating to any investigational purpose associated with any sale or offer to sell any goods or services relating to a product or process for detecting and/or quantifying a polynucleotide using target capture and amplification developed by Gen-Probe, either by itself or with another person, including but not limited to Gen-Probe's NAT test kits for use in detecting HCV or HTV, including any document reflecting the nature of any information to be gathered, any obligation to report results by Gen-Probe, any limitations on the nature or extent of the use to which the product may be put by the purchaser, and any anticipated future commercial benefit from providing such goods or services to customers.

RESPONSE TO DOCUMENT REQUEST NO. 43:

Gen-Probe incorporates into this response each of the foregoing General Responses and General Objections as if fully set forth herein. Gen-Probe further objects that this request is vague and ambiguous with respect to the term "amplification." Gen-Probe further objects that the term "investigational purpose associated with any sale or offer to sell any goods or services relating to a product or process for detecting and/or quantifying a polynucleotide using target capture and amplification" is vague and ambiguous leaving Gen-Probe to guess as to its meaning. Without waiving, and subject to, the foregoing objections, Gen-Probe will produce a complete set of non-privileged, design specification documents concerning the design and method of operation of Gen-Probe's NAT test kits for use in detecting HCV or HIV and the non-privileged books and records subject to paragraph 3.9 of the parties' license agreement concerning the '338 patent.

DOCUMENT REQUEST No. 44:

All documents evidencing, relating, or referring to the efficacy, efficiency, cost, speed, accuracy, or desirability of assays or methods for detecting and or quantifying a polynucleotide involving either target capture or amplification but not both.

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1 **RESPONSE TO DOCUMENT REQUEST NO. 44:**

2 Gen-Probe incorporates into this response each of the foregoing General Responses and
3 General Objections as if fully set forth herein. Gen-Probe further objects that this request is vague
4 and ambiguous with respect to the term "amplification." Gen-Probe further objects that this
5 request is temporally overbroad to the extent that it seeks documents created after the effective
6 filing date of the application that led to the '338 patent. Subject to the temporal limitation and
7 without waiving, and subject to, the other foregoing objections, Gen-Probe will produce non-
8 privileged, responsive documents in its possession, custody and control, that otherwise may
9 constitute prior art.

10 **DOCUMENT REQUEST NO. 45:**

11 All documents evidencing, relating, or referring to alternatives to the technique
12 encompassed by the claims of the '338 patent for detecting or quantifying a polynucleotide.

13 **RESPONSE TO DOCUMENT REQUEST NO. 45:**

14 Gen-Probe incorporates into this response each of the foregoing General Responses and
15 General Objections as if fully set forth herein. Gen-Probe further objects that this request is
16 overbroad, unduly burdensome and is not reasonably calculated to lead to the discovery of
17 admissible evidence. Gen-Probe also objects on the grounds that the term "technique
18 encompassed by the claims of the '338 patent" is vague and ambiguous leaving Gen-Probe to
19 guess as to its meaning and the scope of such claims. Gen-Probe further objects to this request to
20 the extent that it prematurely seeks the facts and contentions that Gen-Probe may advance at trial
21 before the completion of investigation and discovery. Gen-Probe further objects that this request
22 is temporally overbroad to the extent that it seeks documents created after the effective filing date
23 of the application that led to the '338 patent. Subject to the temporal limitation and without
24 waiving, and subject to, the other foregoing objections, Gen-Probe will produce non-privileged,
25 responsive documents in its possession, custody and control, that otherwise may constitute prior
26 art.

27 **DOCUMENT REQUEST NO. 46:**

28 All documents evidencing, relating, or referring to the feasibility of cloning as an

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1 amplification technique in assays or methods for detecting or quantifying a polynucleotide.

2 **RESPONSE TO DOCUMENT REQUEST NO. 46:**

3 Gen-Probe incorporates into this response each of the foregoing General Responses and
4 General Objections as if fully set forth herein. Gen-Probe further objects that this request is vague
5 and ambiguous with respect to the term "amplification." Gen-Probe further objects that this
6 request is overbroad, unduly burdensome and is not reasonably calculated to lead to the discovery
7 of admissible evidence. Gen-Probe further objects to this request to the extent that it prematurely
8 seeks the facts and contentions that Gen-Probe may advance at trial before the completion of
9 investigation and discovery. Gen-Probe further objects that this request is temporally overbroad to
10 the extent that it seeks documents created after the effective filing date of the application that led
11 to the '338 patent. Subject to the temporal limitation and without waiving, and subject to, the
12 other foregoing objections, Gen-Probe will produce non-privileged, responsive documents in its
13 possession, custody and control, that otherwise may constitute prior art.

14 **DOCUMENT REQUEST NO. 47:**

15 All documents evidencing, relating, or referring to the feasibility of cell-free protein
16 expression as an amplification technique in assays or methods for detecting or quantifying a
17 polynucleotide.

18 **RESPONSE TO DOCUMENT REQUEST NO. 47:**

19 Gen-Probe incorporates into this response each of the foregoing General Responses and
20 General Objections as if fully set forth herein. Gen-Probe further objects that this request is
21 overbroad, unduly burdensome and is not reasonably calculated to lead to the discovery of
22 admissible evidence. Gen-Probe further objects that this request is vague and ambiguous with
23 respect to the term "amplification." Gen-Probe further objects to this request to the extent that it
24 prematurely seeks the facts and contentions that Gen-Probe may advance at trial before the
25 completion of investigation and discovery. Gen-Probe further objects that this request is
26 temporally overbroad to the extent that it seeks documents created after the effective filing date of
27 the application that led to the '338 patent. Subject to the temporal limitation and without waiving,
28 and subject to, the other foregoing objections, Gen-Probe will produce non-privileged, responsive

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documents in its possession, custody and control, that otherwise may constitute prior art.

DOCUMENT REQUEST NO. 48:

All documents evidencing, relating, or referring to the feasibility of reverse transcription of RNA or DNA as an amplification technique in assays or methods for detecting or quantifying a polynucleotide.

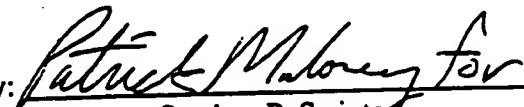
RESPONSE TO DOCUMENT REQUEST NO. 48:

Gen-Probe incorporates into this response each of the foregoing General Responses and General Objections as if fully set forth herein. Gen-Probe further objects that this request is overbroad, unduly burdensome and is not reasonably calculated to lead to the discovery of admissible evidence. Gen-Probe further objects that this request is vague and ambiguous with respect to the term "amplification." Gen-Probe further objects to this request to the extent that it prematurely seeks the facts and contentions that Gen-Probe may advance at trial before the completion of investigation and discovery. Gen-Probe further objects that this request is temporally overbroad to the extent that it seeks documents created after the effective filing date of the application that led to the '338 patent. Subject to the temporal limitation and without waiving, and subject to, the other foregoing objections, Gen-Probe will produce non-privileged, responsive documents in its possession, custody and control, that otherwise may constitute prior art.

Dated: June 20, 2000

COOLEY GODWARD LLP
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GEN-PROBE INCORPORATED
R. WILLIAM BOWEN, JR. (102178)

By: 
Stephen P. Swinton

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Gen-Probe Incorporated

PROOF OF SERVICE BY MAIL

I, Liz Hoke, hereby declare:

I am employed in the City of San Diego, County of San Diego, California in the office of a member of the bar of this court at whose direction the following service was made. I am over the age of eighteen years and not a party to the within action. My business address is Cooley Godward LLP, 4365 Executive Drive, Suite 1100, San Diego, California 92121-2128. I am personally and readily familiar with the business practice of Cooley Godward LLP for collection and processing of correspondence for mailing with the United States Postal Service, pursuant to which mail placed for collection at designated stations in the ordinary course of business is deposited the same day, proper postage prepaid, with the United States Postal Service.

On June 20, 2000, I served: GEN-PROBE INCORPORATED'S RESPONSES TO VYSIS, INC.'S SECOND SET OF REQUESTS FOR PRODUCTION OF DOCUMENTS, GEN-PROBE INCORPORATED'S OBJECTIONS TO VYSIS, INC.'S FIRST SET OF REQUESTS FOR PRODUCTION OF DOCUMENTS, GEN-PROBE INCORPORATED'S OBJECTIONS AND RESPONSES TO VYSIS, INC.'S FIRST SET OF INTERROGATORIES; GEN-PROBE INCORPORATED'S OBJECTIONS AND RESPONSES TO VYSIS, INC.'S SECOND SET OF INTERROGATORIES on the interested parties in this action by placing a true copy thereof, on the above date, enclosed in a sealed envelope, following the ordinary business practice of Cooley Godward LLP, for collection and mailing in the United States mail addressed as follows:

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I declare under penalty of perjury under the laws of the State of California that the